

REMARKS

This paper responds to the Final Office Action dated December 22, 2010. Claims 1, 11, and 21 are presently amended. Claims 5-7 and 15-17 were previously canceled, and claims 4, 14, and 22-27 are canceled herein. No claims are presently added. As a result, claims 1-3, 8-13, and 18-21 remain pending in this application.

Claim Amendments

Each of independent claims 1, 11, and 21 is presently amended to include subject matter previously recited in claims 4 and 14, which are canceled herein, as well as subject matter set forth in the originally filed application. Support for these amendments is found in the originally filed specification, for example, at page 5, lines 29-30. No new matter is added. It is respectfully requested that the claim amendments be entered and considered.

The Rejection of Claims Under § 112

Claims 22-27 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.¹ Claims 22-27 are presently canceled to facilitate prosecution of the instant application and without any admission that claims 22-27 fail to comply with 35 U.S.C. § 112, first paragraph. It is respectfully requested that these rejections be withdrawn.

The Rejection of Claims Under § 103

Claims 1-4, 8-14, and 18-27 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rhoads *et al.* (U.S. Patent Application Publication 2002/0032864, “Rhoads”) in view of page 1, lines 11-13 and page 1, line 19 - page 2, line 13 of the originally filed specification, which was referred to as “applicant’s admitted prior art” (“AAPA”) in the Final Office Action, or alternatively, over AAPA in view of Rhoads. Without any admission that AAPA constitutes actual prior art, the discussion below treats AAPA as hypothetical prior art,

¹ Final Office Action at 3.

solely for the sake of argument, to show that the pending claims, as amended herein, are patentable over the combination of Rhoads and AAPA.

The question of obviousness is resolved on the basis of underlying factual determinations including (1) “the scope and content of the prior art,” (2) “differences between the claimed subject matter and the prior art,” (3) “the level of ordinary skill in the art,” and (4) where in evidence, “secondary considerations.”² When determining whether a claim is obvious, an examiner must make “a searching comparison of the claimed invention – including **all its limitations** – with the teaching of the prior art.”³ “**All words** in a claim must be considered in judging the patentability of that claim against the prior art.”⁴ Inherency of a claim element “requires that the missing descriptive material is ‘**necessarily present**,’ not merely **probably** or **possibly** present, in the prior art.”⁵ “The mere fact that a certain thing **may** result from a given set of circumstances is not sufficient.”⁶ Here, no determination of obviousness is properly established with respect to the amended independent claims 1, 11, and 21, for at least the reason that the scope and content of the cited references, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements.

Each of independent claims 1, 11, and 21 is presently amended to recite, in part, “**the trigger time point (T_n; T_{n+1}) corresponding to at least one of a predetermined distance from the start of the segment or a predetermined distance from the end of the segment.**”⁷ These claim elements of were previously recited in claims 4 and 14, which are canceled herein. The Final Office Action cited to paragraphs 0014 and 0021 of Rhoads as allegedly disclosing these

² *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467, *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406-7, 82 U.S.P.Q.2d 1385, 1390 (2007), cited in *Ex parte Frye*, Appeal No. 2009-006013 (BPAI 2010) (precedential).

³ *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995), emphasis added; *see also Ex Parte Wada and Murphy*, Appeal No. 2007-3733 (BPAI 2008).

⁴ *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970), emphasis added; *see MPEP* § 2143.03.

⁵ *In re Robertson*, 169 F.2d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999), citing *Continental Can Co. USA, Inc., v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991), emphasis added.

⁶ *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981), emphasis added; *see also Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (BPAI 1986) (“[T]he Examiner must provide some evidence or scientific reasoning to establish the reasonableness of the Examiner's belief that the functional limitation is an **inherent** characteristic of the prior art' before the burden is shifted to the Applicant to disprove inherency,” emphasis added).

⁷ Emphasis added.

claim elements.⁸ The entirety of Rhoads, however, including the cited paragraphs, actually fails to disclose these claim elements.

The cited paragraph 0014 of Rhoads simply states that a “fingerprint may be derived by applying content – in whole or part . . . – to a neural network,”⁹ giving as an example the “feeding [of] the first 30 seconds of audio, with 20 millisecond [F]ourier transformed windows, into a Kohonen network having 64 outputs.”¹⁰ There is no discussion, however, of a “**trigger time point**” in the cited paragraph 0014 of Rhoads, as well as no discussion of a “**start**” or “**end**” of a segment, much less a “**predetermined distance from**” the start or end of the segment. Simply discussing application of content, in whole or in part, to a neural network fails to teach or suggest a “trigger time point . . . corresponding to at least one of a predetermined distance from the start of the segment or a predetermined distance from the end of the segment,” as recited in the amended independent claims. Mere mention of “feeding the first 30 seconds of audio” in an example of applying content to a neural network similarly makes no mention of these claim elements. Thus, the cited paragraph 0014 of Rhoads fails to teach or suggest these claim elements.

The cited paragraph 0021 of Rhoads discusses “fingerprinting algorithms.”¹¹ In this paragraph, Rhoads uses the word “windows” of “a few seconds, or fractions of seconds” in describing “excerpt[s]” of an “audio track”¹² and states that “one convenient unit from which excerpts can be formed is the frame or window used in the compression algorithm (e.g., the excerpt can be one frame, five frames, etc.).”¹³ There is no discussion, however, of a “**trigger time point**” in the cited paragraph 0021 of Rhoads, as well as no discussion of a “**start**” or “**end**” of a segment, much less a “**predetermined distance from**” the start or end of the segment. Mere mention of “windows,” “excerpts,” or “frames” of an audio track fails to teach or suggest a “trigger time point . . . corresponding to at least one of a predetermined distance from

⁸ Final Office Action at 7.

⁹ Rhoads at paragraph 0014.

¹⁰ *Id.*

¹¹ Rhoads at paragraph 0021.

¹² *Id.*

¹³ *Id.*

the start of the segment or a predetermined distance from the end of the segment,” as recited in the amended independent claims. Thus, the cited paragraph 0021 of Rhoads fails to teach or suggest these claim elements.

Nothing in the entirety of Rhoads, in fact, makes any mention of a “**start of [a] segment**” or an “**end of [that] segment**,” let alone a “**predetermined distance from the start** of the segment” or a “**predetermined distance from the end** of the segment.” Indeed, Rhoads is entirely silent with respect to a “start” or “end” of anything. Rhoads is therefore entirely silent with respect to a “predetermined distance from” the start or the end of something. Accordingly, the entirety of Rhoads does not teach or suggest a “trigger time point . . . corresponding to at least one of a predetermined distance from the start of the segment or a predetermined distance from the end of the segment,” as recited in each of independent claims 1, 11, and 21.

Although the Final Office Action cited exclusively to Rhoads with respect to these claim elements, AAPA makes no mention of “start of [a] segment” or an “end of [that] segment,” let alone a “predetermined distance from the start of the segment” or a “predetermined distance from the end of the segment.” As a result, the combination of Rhoads and AAPA fails to teach or suggest a “**trigger time point . . . corresponding to at least one of a predetermined distance from the start of the segment or a predetermined distance from the end of the segment**,” as recited in each of independent claims 1, 11, and 21.

For at least these reasons, the scope and content of Rhoads and AAPA, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements. As a result, a determination of obviousness is not established with respect to any of independent claims 1, 11, and 21, and their respective dependent claims, including claims 2, 3, 8-10, 12, 13, and 18-20. Moreover, the dependent claims each may be patentable based on limitations recited therein. Thus, it is respectfully requested that these rejections be reconsidered and withdrawn and that the claims be allowed.

CONCLUSION

It is respectfully submitted that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402--0938
(408) 278-4048

Date 16 March 2011

By /


Joseph J. Wang
Reg. No. 61,123